PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of:			
Application No.:	10/574,831	**Examiner:**	Carol M. Koslow
Filing Date:	December 19, 2006	**Art Unit:**	1793
First Inventor:	Thomas GIERING	**Customer No.:**	23364
Attorney No.:	GIER3008/JEK	**Confirmation No.:**	5012
For:	CODING SYSTEM FOR VALUE DOCUMENTS		

SUPPLEMENTAL SUBMISSION TO ACCOMPANY REQUEST FOR CONTINUED EXAMINATION (37 C.F.R. §1.114)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicant requests entry of the response and amendment filed in this application on April 12, 2010, entry of which was refused by the examiner in the Advisory Action mailed April 20, 2010 on grounds that the proposed amendment appears to create a 35 U.S.C. §101 double patenting issue with regard to Application No. 10/574,662.

From the Advisory Action, it appears that the only issue remaining to be resolved in this application is the issue of double patenting under 35 U.S.C. §101 of the claims of this application as they relate to the claims of co-owned Application No. 10/574,662 (the '662 application).

As the examiner is aware, the issue of statutory double patenting arises when the claimed inventions between two applications are substantially the same. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.* 151 US 186 (1984); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

As stated in MPEP 804, in determining whether a statutory basis for double patenting rejection exists, the question to be asked is: is the same invention being claimed twice?

For the convenience of the examiner, claim 1 of the present application is reproduced below:

> 1. A composition for forming a security coding, the composition comprising at least one pair of mutually associated luminescent substances, said at least one pair including first and second luminescent substances which emit in a joint emission range located outside the visible spectral range, the emission spectra of the first and second luminescent substances overlapping in at least a subrange of said joint emission range such that the emission spectrum of the first luminescent substance is complemented characteristically by the emission spectrum of the second luminescent substance, wherein the first and second luminescent substances emit in the subrange with respective emission spectra peaks so close as to practically prevent individual recognition of the first and second luminescent substances from an envelope of luminescent emissions defined by the joint emission range without further information, whereby the composition is usable as a security coding.

For comparison, claim 1 of the '662 application as currently amended is reproduced below:

> 1. A composition for a coding forming at least part of a coding system for a value document, comprising: a *luminescent basic substance* and *at least one luminescent additive*;
>
> wherein the *luminescent basic substance* and the *luminescent additives* each have coding-relevant emission lines located in a joint emission range; and *first and second luminescent additives* are provided which form a pair of mutually associated luminescent substances, the emission spectra of the first and second additives, which are so similar so as to be indistinguishable, overlapping in at least a subrange of the joint emission range. (italics added)

A close comparison of the two independent claims as reproduced above will immediately reveal that claim 1 of the '662 application relates to a composition for coding a value document that comprises a luminescent basic substance and luminescent additive, the latter each having coding-relevant emission lines located in a joint emission range, and further wherein first and second luminescent additives are provided which form a pair of mutually associated luminescent substance, the emission spectra of the first and second

additives being so similar as to be indistinguishable and overlapping in at least a sub range of the joint emission range.

Claim 1 of the present application does not recite a luminescent basic substance nor does it recite luminescent additives associated with the luminescent basic substance. Rather, claim 1 of this application recites a composition comprising at least one pair of mutually associated luminescent substance which emit in a joint emission range located outside the visible spectral range, wherein the emission spectra of the first and second luminescent substances overlap in at least a subrange of said joint emission range such that the emission spectrum of the first luminescent substance is complemented characteristically by the emission spectrum of the second luminescent substance. Further in accordance with this claim, the first and second luminescent substances emit in the subrange with respective emission spectra peaks so close as to practically prevent individual recognition of the first and second luminescent substances from an envelope of luminescent emissions defined by the joint emission range without further information, such that the composition is useable as a security coding.

The differences between the claims thus become quite evident. The composition of claim 1 of the'662 application, requires, in addition to *luminescent additives* (which appear to be comparable to the first and second luminescent substances of claim 1 of this application), a *luminescent basic substance* which has, together with the luminescent additives, *a coding relevant emission line* in a joint emission range.

In accordance with the '662 claim 1, the *luminescent basic substance* is essential, since it ensures security of the composition due to the fact that the basic substance can only be identified by user groups making extremely high demands on an authenticity check. The *luminescent additives*, on the other hand, are easier to identify and are mainly provided to enlarge the number of possible codings.

In accordance with claim 1 of this application, no such *luminescent basic substance* is recited.

Accordingly, due to the fact that claim 1 of the '662 application requires both a *luminescent basic substance* and *first and second luminescent additives*, neither of which is recited in claim 1 of the present application, the inventions recited in the respective claims cannot be regarded as "the same".

Accordingly, entry of the amendment to claim 1 is appropriate, such entry placing the application fully in condition for allowance.

Claim 18 of the present application recites a *value document* comprising the composition of claim 1. Because claim 1 of the '662 application relates to a composition, not a value document, the inventions may not be regarded as "the same". Accordingly, no statutory double patenting issue is presented between the inventions recited in claim 18 of the present application and claim 1 of the '662 application.

For the examiner's convenience, the second independent claim presented in the '662 application, claim 26, is presented below:

> 26. A composition for a coding forming at least part of a coding system for a value document, comprising: a *luminescent basic substance* and *at least one luminescent additive*;
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> wherein the luminescent basic substance and the luminescent additives each have coding-relevant emission lines located in a joint emission range; and first and second luminescent additives are provided which form a pair of mutually associated luminescent substances, the emission spectra of the first and second additives, which overlap each other so that the presence of the first and second luminescent additives can practically not be recognized. (italics added)

Like claim 1, claim 26 of the '662 application recites both a basic luminescent substance and at least one luminescent additive, wherein the luminescent basic substance and the luminescent additives each have coding-relevant emission lines.

As discussed above, claim 1 does not recite a luminescent basic substance in combination with at least one luminescent additive.

Claim 26 of the '662 application recites that the luminescent additives each have coding-relevant emission lines located in a joint emission range wherein first and second luminescent additives are provided to form a pair of mutually associated luminescent substances having emission spectra which overlap each other so that the presence of the first and second luminescent additives can practically not be recognized.

Claim 1 of the present application, on the other hand, recites that the first and second luminescent substances emit in the subrange with respective emission spectra peaks so close as to practically prevent individual recognition of the first and second luminescent substances from an envelope of luminescent emissions defined by the joint emission range without further information. Clearly, the recitation of the detailed description of the emission spectra of the first and second luminescent substances of claim 1 of this application is clearly

distinguishable over the broad recitation of claim 26 of the '662 application that: "the emission spectra of the first and second additives overlap each other so that the presence of the first and second luminescent additives can practically not be recognized."

Accordingly, Applicant submits that the invention recited in claim 1 of the present application cannot be regarded as the same as that recited in claim 26 of the '662 application.

As noted previously, claim 18 of the present application relates to a value document comprising the composition of claim 1 of the present application, wherein claim 26 recites a composition for a coding as discussed above. Clearly, the invention of claim 18 of this application may not be regarded as the same as the invention recited in claim 26 of the '662 application.

In summary, Applicant respectfully submits that an issue of statutory double patenting does not arise in view of the amendments made to the claims of the present application with regard to the claims of the '662 application. Further, Applicant submits again that the claims of this application as currently amended fully overcome the rejections expressed in the final rejection under 35 U.S.C. §102 and §103 for reasons expressed in the previously presented response.

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Respectfully submitted,

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